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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/698,174	10/30/2003	Howard Shelton Lambert	GB920020091US1	2506
35525	7590	07/31/2007		
IBM CORP (YA) C/O YEE & ASSOCIATES PC P.O. BOX 802333 DALLAS, TX 75380			EXAMINER LASHLEY, LAUREL L	
			ART UNIT 2132	PAPER NUMBER
			MAIL DATE 07/31/2007	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

Application No.

10/698,174

Applicant(s)

LAMBERT ET AL.

Examiner

Laurel Lashley

Art Unit

2132

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 24 May 2007.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-18 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

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### DETAILED ACTION

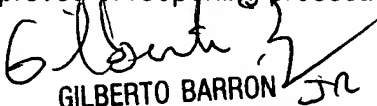
1. In view of the Pre-Appeal Brief filed on 05/24/2007, PROSECUTION IS HEREBY REOPENED. A new ground of rejection is set forth below.

To avoid abandonment of the application, appellant must exercise one of the following two options:

(1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final); or,

(2) initiate a new appeal by filing a notice of appeal under 37 CFR 41.31 followed by an appeal brief under 37 CFR 41.37. The previously paid notice of appeal fee and appeal brief fee can be applied to the new appeal. If, however, the appeal fees set forth in 37 CFR 41.20 have been increased since they were previously paid, then appellant must pay the difference between the increased fees and the amount previously paid.

A Supervisory Patent Examiner (SPE) has approved of reopening prosecution by signing below:

  
GILBERTO BARRON JR.  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 2100

2. Claims 1 – 18 are still pending and have been examined.

### ***Claim Objections***

3. Applicant's argument with respect to the objection to the specification and drawings are persuasive, therefore the objection is withdrawn.

### ***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

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4. Claims 12, 17 and 18 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Claim 12 is non-statutory, directed to software, per se, lacking storage on a medium that enables any underlying functionality to occur. Applicant's amendment to merely recite "[a] computer program on a tangible medium..." does not place the claim within any of the four statutory categories of invention.

With regard to Applicant's assertion that Grill in US Patent No. 7212905 discloses "the exact same language provided in claim 12", the Examiner respectfully disagrees. Applicant's attention is drawn to the provided claim of Grill where it is recited (emphasis added) that "...*when executed on a computer and stored on a storage medium*..." It is this disclosure, not the included preceding "tangible medium" portion of the claim that renders it statutory. As such, Applicant's claim 12 does not include such a disclosure and therefore cannot be equated to the Grill patent. The Examiner maintains the rejection of claims 12, 17 and 18 for at least these reasons.

To expedite a complete examination of the application, the claims rejected less than 35 U.S.C. 101 above are further rejected as set forth below in anticipation of Applicant amending the claim to place it within the four statutory categories of invention.

#### **Claim Rejections - 35 USC § 103**

5. **Claims 1-8 and 10-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Holvey et al., U.S. Patent Publication No. 2004/0054935, (hereinafter "Holvey"), in view of Prihoda et al., U.S. Patent No. 6,789,195, (hereinafter "Prihoda").**

6. **Regarding claims 1, 11 and 12:** Holvey discloses a data processing system (Title), method (Title), and an executable computer program on a tangible medium ([0038] software), respectively, for controlling access of at least one user to stored data comprising:

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means, responsive to a request from the user to access a set of the stored data that is available to the at least one user, for authenticating the user ([0022] requesting user authenticated via voice-print or ID and password); and

a user specific table associated with the user (patient medical records and associated authorized users), wherein the user specific table identifies the set ([0023]-[0024] Table 1).

Holvey does not disclose decrypting the user specific table or accessing the set in response to successful decryption.

Prihoda discloses means, responsive to successful authentication, for decrypting a user specific table associated with the user (col. 1, ll. 57-65, storage...data...decrypted...); and means, responsive to successful decryption, for accessing the set (col. 2, ll. 15-20, authorized data access with key...).

As one of ordinary skill in the art at the time of the invention would know, encrypting documents has been well-known since long before the invention. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify Holvey by encrypting and decrypting data as taught by Prihoda in order to maintain confidentiality of users' information. (see Prihoda, col. 2 ll. 15-16).

**Regarding claim 2:** Holvey discloses that the user specific table comprises data associated with the location of the set ([0032] hyperlinks).

**Regarding claim 3:** Holvey does not disclose that the set is encrypted or that the user specific table comprises data associated with decryption of the set.

Prihoda discloses that the set is encrypted and the user specific table comprises data associated with decryption of the set (col. 2, ll. 15-20, special key for decrypting).

Encrypting documents has been well-known since long before the invention, therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify

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Holvey by encrypting and decrypting data as taught by Prihoda in order to maintain confidentiality of users' information, (see Prihoda, col. 2 ll. 15-16).

**Regarding claim 4:** Holvey discloses a set comprising all of the stored data ([0023] complete set of rights).

**Regarding claim 5:** Holvey discloses a set comprising portion of the stored data ([0023] limited rights).

**Regarding claim 6:** Holvey discloses a request initiated by presentation of a token by the user ([0022] token).

**Regarding claim 7:** Holvey discloses a token comprising means associated with an identity of the user ([0022] user specific token).

**Regarding claim 8:** Holvey discloses a means associated with the identity of the user derived from one or more biometric characteristics associated with the user ([0022] and [0031] voice-print).

**Regarding claim 10:** Holvey discloses stored data capable of access by more than one user ([0023] owners/patients and other authorized users), and means for accessing data associated with each user of the more than one users ([0023] patients have complete access, other authorized users' access is controlled by patients).

**7. Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of Holvey and Prihoda as applied to claim 1 above, and further in view of Chadwick, "Smart Cards Aren't Always the Smart Choice," IEEE Computer, December 1999, v. 32, issue 12, pp. 142-143, (hereinafter "Chadwick").**

**8. Regarding claim 9:** Holvey discloses a token ([0022]). Holvey does not disclose the token comprising the means for decrypting. Prihoda discloses a token comprising the means for decrypting (Abstract and col. 2, ll. 15-20, key for decrypting).

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As one of ordinary skill in the art at the time of the invention would know, software tokens have been well-known since long before the invention, (see Chadwick, p. 142, col. 1-2, regarding public/private key infrastructure software tokens). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify Holvey by encrypting and decrypting data as taught by Prihoda in order to maintain confidentiality of users' information, (see Prihoda, col. 3 ll. 20-21).

9. **Claims 13-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of Holvey and Prihoda as applied to claim 1 above, and further in view of Mita et al., U.S. Patent Publication No. 2002/0035485 A1, (hereinafter "Mita").**

10. **Regarding claims 13, 15 and 17:** Holvey discloses additional user specific tables for each additional user ([0007] patient database, i.e., collection of patient tables).

Mita discloses means for attempting to decrypt, in turn, each of the user specific tables until a successful decryption occurs ([0042] sequential search).

As one of ordinary skill in the art at the time of the invention would know, sequential searching has been well-known since long before the invention. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify Holvey by sequential searching as taught by Mita in order to access stored personal including medical data (see Mita, Title).

**Regarding claims 14, 16, and 18:** Holvey discloses that the user specific table comprises data associated with the location of the set ([0032] hyperlinks).

### ***Conclusion***

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Laurel Lashley whose telephone number is 571-272-0693. The examiner can normally be reached on Monday - Thursday, alt Fridays btw 7:30 am & 5 pm.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gilberto Barron, Jr. can be reached on 571-272-3799. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

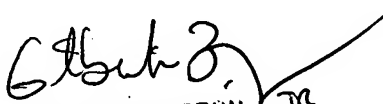
Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Laurel Lashley  
Examiner  
Art Unit 2132



26 July 2007

LLL



GILBERTO BARRON JR  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 2100